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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,409	03/27/2002	Wilhelm Stork	P/4074-4	1789

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT PAPER NUMBER

3738

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/009,409

Applicant(s)

STORK ET AL.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

✓ 1. The preliminary amendment filed 3/27/02 has been entered as Paper No. 7. Changes to the specification and abstract have been approved by the examiner. Claims 1-16 have been amended and new claim 17 has been added. It appears that applicant wants to delete page 9, lines 1-9 of the specification. This amendment should be made by clearly instructing the deletion of those lines using the word "delete" in the response to this office action.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

→ The oath or declaration is defective because:  
It does not identify the application as a 371 of PCT/EP00/04888 filed on 5/29/2000. The declaration is defective also because the filing date indicated, 12/10/01, is incorrect. It should be changed to 3/27/02.

### ***Drawings***

✓ 3. The drawings are objected to because the labels of the axes in Figure 2 are not in English and need to be changed to English. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

✓ 4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

✓ 5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a) In claim 8, “the annular lens area has a width of approximately 0.8 mm to 0.9 mm” requires support in the specification.

b) In claim 9, “the central lens area has a diameter of approximately 4 mm” requires support in the specification.

c) In claim 11, “the central lens area has a smooth surface” requires support in the specification.

d) In claim 17, “the annular lens area has a width of approximately 0.8 mm to 0.9 mm, in particular 0.835 mm” requires support in the specification.

***Claim Objections***

6. Claims 1 and 6 are objected to because of the following informalities:

✓ a) In claim 1, line 2, “further” indicates an additional annular lens area. Since the central lens part is not an annular lens area, examiner suggests deleting “further”.

✓ b) In claim 6, line 2, examiner suggests deleting “further” on line 2 for the same reason as claim 1, supra. The word --having-- should be inserted after “section”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ 8. Claim 13 is indefinite because it is unclear if the clause "forming the refractive component" on line 2 means that that the central lens area forms the refractive component or if the additional diffractive zone provided on the central lens area form the refractive component.

✓ 9. Claims 14 and 15 recite the limitation "the adjacent diffractive zones" in lines 2-3 and 2, respectively. There is insufficient antecedent basis for this limitation in the claims because claim 13, on which they depend, does not require the additional diffractive zones to be adjacent one another.

✓ 10. Claim 14 is indefinite because on line 3, it is unclear if "a design wavelength" is the same as the design wavelength of claim 1. If it is, examiner suggests changing "a design wavelength" to --the design wavelength--.

✓ 11. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by

raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 17 recites the broad recitation “approximately 0.8 mm to 0.9 mm”, and the claim also recites “in particular 0.835 mm” which is the narrower statement of the range/limitation. In amending this claim, applicant should keep in mind the scope of claim 8 and not duplicate it.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-7 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Meur (EP 0276331 A1 as cited in applicant’s IDS).

Meur discloses an intraocular lens with all the elements of claim 1. See columns 2-3, lines 2-21 and figures for an IOL with an optical lens part that comprises a central lens area (1) and at least one annular lens area (3) surrounding the central lens area (1), the central lens area (1) and the at least one annular lens area (3) forming a common focus and the annular lens area (3) comprising concentric annular zones (4, 5, 6) in which the difference in the beam path

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lengths between adjacent zones (4, 5, 6) is an integral multiple of  $n=2$  or more of a design wave length.

Claims 2-7 and 10-16, see columns 2-3, lines 2-21.

14. Claims 1-7 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Stork et al. (EP 0537643 A1).

Stork et al. discloses an intraocular lens with all the elements of claim 1. See translated abstracts and figures for an IOL with an optical lens part that comprises a central lens area and at least one annular lens area surrounding the central lens area, the central lens area and the at least one annular lens area forming a common focus and the annular lens area comprising concentric annular zones in which the difference in the beam path lengths between adjacent zones is an integral multiple of  $n=2$  or more of a design wave length.

Claims 2-7 and 10-16, see translated abstracts and figures.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8, 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meur.

Meur discloses an intraocular lens with all the elements of claim 1, but is silent to the annular lens area having an annular width of approximately 0.8 mm to 0.9 mm and the central

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lens area having a diameter of approximately 4 mm, as required by claims 8, 9 and 17. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the dimensions of the IOL of the specified lengths because applicant has not disclosed that the specified width and diameter provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with widths and diameters of other lengths because the ability for the IOL to produce a higher quality image on the retina is not affected by the width and diameter of the annular lens area and central lens area, respectively. Additionally, these dimensions will vary from patient to patient to meet individual needs and to fit individual pupil sizes. Therefore, it would have been an obvious matter of design choice to modify Meur to obtain the invention as specified in claims 8, 9 and 17.

17. Claims 8, 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al.

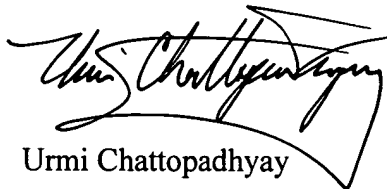
Stork et al. discloses an intraocular lens with all the elements of claim 1, but is silent to the annular lens area having an annular width of approximately 0.8 mm to 0.9 mm and the central lens area having a diameter of approximately 4 mm, as required by claims 8, 9 and 17. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the dimensions of the IOL of the specified lengths because applicant has not disclosed that the specified width and diameter provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with widths and

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diameters of other lengths because the ability for the IOL to produce a higher quality image on the retina is not affected by the width and diameter of the annular lens area and central lens area, respectively. Additionally, these dimensions will vary from patient to patient to meet individual needs and to fit individual pupil sizes. Therefore, it would have been an obvious matter of design choice to modify Stork et al. to obtain the invention as specified in claims 8, 9 and 17.

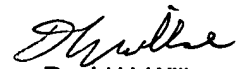
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 305-3590. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

Art Unit 3738



David H. Willse  
Primary Examiner

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June 12, 2003